

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/114,810 07/13/98 ATALA

A CME-117

LAHIVE AND COCKFIELD  
28 STATE STREET  
BOSTON MA 02109

QM32/0606

EXAMINER

RODRIGUEZ, C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3763

DATE MAILED:

06/06/00

*9*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

|                 |            |                |             |
|-----------------|------------|----------------|-------------|
| Application No. | 09/114,810 | Applicant(s)   | Atala et al |
| Examiner        | CJL        | Group Art Unit | 3763        |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on 3/27/00.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 1-50 is/are pending in the application.
- Of the above claim(s) 1-18, 21-50 is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-6, 19, 20 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 4, 6  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election without traverse of Group I, Figures 1-3, claims 1-20 in Paper No. 8 is acknowledged. Because Applicant did not further elected the claims readable in the elected species, the Examiner called Jeanne M. DiGiorgio on May 25, 2000, to expedite the prosecution of the case, and requested an election of the claims on the elected species. Counselor elected claims 1-14, 19 and 20. However, claims 1-6, 19 and 20 have been found by the Examiner to read in the elected species of figure 1-3.
2. Claims 7-18 and 21-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### *Drawings*

- (3.) The drawings are objected to because on page 15 line 12, reference numeral "27" is not shown in figure 9; on page 16 line 7, reference numerals "60" and "20c" are not shown in the drawings; Figure 10 does not have a transversal cut line to show what is shown in figure 11. Correction is required.

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***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the device comprising a battery as set forth in claim 20 for the elected species.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1-6 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bock(5,618,275).

Bock discloses an ultrasonic device comprising an applicator 1,2,3 and an ultrasound transducer 13.

7. Claims 1, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogden(5,656,016).

Ogden discloses a drug delivery device comprising an applicator 12, an ultrasound transducer and a detector for monitoring feedback signals from the transducer(col 4 lines 17-23).

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***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McDaniel, Driller et al, Hall et al, Newman, and Mitragotri et al all disclose a device analogous to that as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on Monday-Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, Corrine McDermott can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

*CJR 6/1/00*  
Cris L. Rodriguez  
June 1, 2000

*CB*  
CORRINE McDERMOTT  
PRIMARY EXAMINER